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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/819,669	03/17/1997	THIERRY BOON	LUD-5253.5-D	1995
24972 7590 10/23/2007 FULBRIGHT & JAWORSKI, LLP 666 FIFTH AVE NEW YORK, NY 10103-3198			EXAMINER GAMBEL, PHILLIP	
			ART UNIT 1644	PAPER NUMBER
			MAIL DATE 10/23/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action**  
**Before the Filing of an Appeal Brief**

Application No.

08/819,669

Applicant(s)

BOON ET AL.

Examiner

Phillip Gambel

Art Unit

1644

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED \_\_\_\_\_ FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The Notice of Appeal was filed on 06 August 2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 183-191.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

PHILLIP GAMBEL, PH.D. J.D.  
PRIMARY EXAMINER

R 1600 10/24/07  
PHILLIP GAMBEL

Continuation of 11. does NOT place the application in condition for allowance because: of the reasons of record.

11(A). Applicant's Remarks indicating that the petition to correct inventorship and the granting of the petition via the issuance of a Certificate of Correction in U.S. Patent No. 5,843,448 is acknowledged.

Therefore, the inventors of U.S. Patent No. 5,843,448 are now listed as Yao-Tseng Chen, Elisabeth Stockert, Pilar Garin-Chesa, Wolfgang J. Rettig, Lloyd J. Old, Thierry Boon-Falleur and Pierre Van Der Bruggen.

The inventorship of the instant USSN 08/819,669 is listed as Thierry Boon, Pierre Van Der Bruggen, Benoit Van Den Eynde, Aline Van Pel, Etienne De Plaen, Christophe Lurquin, Patrick Chomez and Catia Traversari.

As applicant notes, there are inventors in common, namely Boon/Boon-Falleur and Van Der Bruggen between the U.S. Patent No. 5,843,448 and the instant USSN 08/819,669.

11(B). Applicant's Remarks concerning the priority of the instant application along with updating the priority on page one of the instant specification is acknowledged.

11(C). Given applicant's Remarks concerning that:

"With respect to common ownership, a statement of such cannot be made, because the ownership of U.S. Patent No. 5,843,448 is joint, whereas the ownership of the current application resides with one party, Ludwig Institute for Cancer Research. The patent and application do not stand as prior art to each other, as each claims precisely the same priority";

the following is noted.

In accordance with MPEP 804,

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Here, the terminal disclaimer is not enforceable since the U.S. Patent and the instant application are not commonly owned.

Given that the U.S. Patent and the instant USSN are not commonly owned, applicant should consider filing a Petition to Expunge according MPEP 724.05 in order to expunge the Terminal Disclaimer previously filed 12/12/2006.

11(D). Claims 183-191 stand rejected under 35 U.S.C. § 102(f) or, in the alternative, under 35 U.S.C. 102(f)/103(a) because the applicants did not invent the claimed subject matter essentially for the reasons of record.

Applicant's Remarks, filed 09/18/2007, that all issues raised by the previous Office Action have been addressed have been fully considered but have not been found convincing essentially for the reasons of record.

Applicant's arguments of record have not been found persuasive and the rejection is maintained for the reasons of record as well as the differences between the inventorship of the instant application and U.S. Patent No. 5,843,448.

Further, it is noted that applicant has admitted in the Remarks, filed 09/18/2007, that the instant application and the U.S. Patent are not commonly owned.

Because of the ambiguity of the inventorship, it is incumbent on applicant to provide a satisfactory showing, which would lead to a reasonable conclusion that the instant listed inventorship are the sole inventors of the claimed invention.

The following of record is reiterated for applicant's convenience.

It is noted that SEQ ID NO: 8 of the instant USSN 08/819,669 is the same sequence as SEQ ID NO: 1 disclosed in Example 5 of U.S. Patent No. 5,843,448 (see 892, mailed 3/28/01) (e.g., see Example 5 on columns 7-8 of U.S. Patent No. 5,843,448).

The patented claims of U.S. Patent No. 5,843,448 are drawn to MAGE-1 tumor rejection antigen precursor proteins and immunogenic compositions, which anticipate the instant MAGE tumor rejection antigen precursor proteins and compositions thereof. Further, it has been well known for decades by the ordinary artisan that vaccines and immunogenic compositions often comprise an adjuvant to increase the immunogenicity of the immunogenic or vaccine composition of interest.

Applicant's arguments, filed 12/12/06, have been fully considered but have not been found convincing essentially for the reasons of record.

In response to applicant's assertions that the inventions must be the same for a 102(f) rejection to be proper,

the 102(f) / 102(f)/103(a) rejection has been set forth to encompass the issues of the claimed subject under 102(f) for the purposes of Sections 102 and 103.

In contrast to applicant assertions, the examiner has not misread the claims, has not misinterpreted the law and has reviewed the cases carefully.

With respect to applicant's assertions that the examiner is estopped from making the rejection under 35 USC 102(f), it is well settled that whether similar claims have been allowed to others is immaterial. See *In re Giolito*, 188 USPQ 645 (CCPA 1976) and *Ex parte Balzarini*, 21 USPQ2d 1892, 1897 (BPAI 1991).

Again, as indicated previously and addressed above, it is noted that U.S. Patent No. 5,843,448 does not have a common inventor with the instant application.

Further, applicant's Response to Office Action, filed 12/12/06, clearly indicates that the inventorship of U.S. Patent No. 5,843,448 is incorrect, which, in turn, supports the ambiguity about inventorship raised in the rejection under 102(f) in the previous Office Action, mailed 9/7/06.

Applicant's assertions that the inventions must be the same, implying that the claims must exactly the same for a proper rejection under 102(f) is not consistent with legal precedent or guidance from the MPEP.

Where it can be shown that an applicant derived an invention from another, a rejection under 35 USC 102(f) is proper. See MPEP 706.02(g) and MPEP 2137.

Prior art under 35 USC 102(f) may be available under 35 USC 103.

See *OddzOn Products, Inc. v. Just Toys, Inc.*, 43 USPQ2d 1641, 1644 (Fed. Cir. 1997)(35 U.S.C. "102(f) is a prior art provision for purposes of § 103"); *Dale Electronics v. R.C.L. Electronics*, 180 USPQ 225, 227 (1st. Cir. 1973); and *Ex parte Andresen*, 212 USPQ 100, 102 (Bd. App. 1981).

See MPEP 2004 and MPEP 706.02(l).

Further, it is noted that derivation is key to a rejection under 35 USC 102(f) and that derivation addresses originality (i.e. who invented the subject matter).

See MPEP 2137.

Also, for conception of specific compounds, one must have a mental picture of the structure or of other characteristics that distinguish it from the prior art.

See *Board of Education ex rel board of Trustees of Florida State University v American Bioscience Inc.*, 67 USPQ2d 1252 (Fed Cir 2003).

Also, see MPEP 2137.01 and 2138.04.

Here, while the recitation of the instant claims does not recite MAGE-1 per se, the instant claims recite a MAGE tumor rejection tumor antigen precursor encoded by the nucleic acid molecule, the complementary sequence of which hybridizes to SEQ ID NO: 8.

SEQ ID NO: 8 of instant USSN 08/819,669 is specifically drawn to MAGE-1.

While the recitation of the issued claims in U.S. Patent No. 5,843,448 does not recite a SEQ ID NO. per se, the issued claims of in U.S. Patent No. 5,843,448 are drawn to MAGE-1 tumor rejection antigen precursors and SEQ ID NO: 1 disclosed in Example 5 in U.S. Patent No. 5,843,448 encoding MAGE-1 tumor rejection antigen precursor is the same sequence as SEQ ID NO: 8 of instant USSN 08/819,669.

Further, it is noted that the instant claims are not limited to tumor rejection antigen precursors comprising / consisting of SEQ ID NO: 8 only.

Also, it is noted that the issued claims of U.S. Patent No. 5,843,448 are not limited to a single species either.

While the scope of the instant and issued claims differ, both sets of claims are clearly drawn to or based upon the same or nearly the same reference sequence encoding tumor rejection antigen precursors, namely SEQ ID NO: 8 in the instant USSN 08/819,669 or SEQ ID NO: 1 in U.S. Patent No. 5,843,448.

It is the base or reference sequence structure encoding tumor rejection antigen precursors (namely SEQ ID NO: 8 in the instant USSN 08/819,669 or the structural limitations comprising SEQ ID NO: 1 in U.S. Patent No. 5,843,448 that is the key characteristic that distinguishes the instant claims from the prior art

Given the base structural characteristics (e.g., sequence, MAGE-1) common to both the instant and patented claims, the instant and patented claims would anticipate one another.

In addition to the anticipation of instant and issued claims over one another, the instant and issued claims both encompass overlapping MAGE tumor rejection antigen precursors encompassing some variability in the structure of said tumor rejection antigen

precursors, wherein the in tumor rejection antigen precursors are encoded by nucleic acids, the complementary of which hybridizes to SEQ ID NO: 8 (see instant claims) or have a molecular weight of about 34.3 - 46 kilodaltons (see claims of U.S. Patent No. 5,843,448) (or SEQ ID NO: 1; see Example Example 5 of U.S. Patent No. 5,843,448).

Further, the record in the instant application clearly indicates that the instant inventorship was responsible for isolating and identifying instant SEQ ID NO: 8 as encoding MAGE tumor rejection antigen precursors (e.g., see Declarations submitted 7/9/98, 6/30/00, 7/10/00 by the instant inventorship to correct SEQ ID NO: 8.).

Again, as pointed out previously and addressed herein,

Given the presumption of validity of U.S. Patent No. 5,843,448 and that no inventors are in common between the instant USSN 08/819,669 and U.S. Patent No. 5,843,448,

there is ambiguity as to who invented the claims drawn to MAGE tumor rejection antigen precursor proteins, including MAGE-1 or SEQ ID NO: 8 recited in the instant claims, forming the basis of the instant MAGE tumor rejection antigen precursor proteins.

As pointed out previously and above, applicant's arguments of record have not been found persuasive and the rejection is maintained for the reasons of record as well as the differences between the inventorship of the instant application and U.S. Patent No. 5,843,448.

Further as noted above, it is noted that applicant has admitted that the instant application and the U.S. Patent are not commonly owned.

Because of the ambiguity of the inventorship, it is incumbent on applicant to provide a satisfactory showing, which would lead to a reasonable conclusion that the instant listed inventorship are the sole inventors of the claimed invention.

Applicant's arguments concerning the inventorship and issues related to the previous Office Action have been fully considered but have not been found persuasive for the reasons of record and that addressed herein.

Therefore, this rejection is maintained.

11(E) Applicant's Remarks, filed 09/18/2007, as follows are acknowledged.

"As has been stated, several times, this application has been pending for ten years. Every single time applicants have addressed the Examiner's issues, he has raised new ones.

It is high time that the prosecution be brought to an end, and the Examiner is called upon to either allow this application or to raise any remaining issues immediately."

As pointed out in the previous Office Action, mailed 02/06/2007;

At this point, there is no need to comment further on applicant's assertions concerning any delay in prosecution, other than to indicate that a number of issues have been addressed during the prosecution of the instant application, including correcting sequences and an appeal to the Board of Appeals and Interferences.

As indicated herein, claims 183-191 stand rejected under 35 U.S.C. § 102(f) or, in the alternative, under 35 U.S.C. 102(f)/103(a) because the applicants did not invent the claimed subject matter essentially for the reasons of record.

As indicated herein, given that the U.S. Patent and the instant USSN are not commonly owned, applicant should consider filing a Petition to Expunge according MPEP 724.05 in order to expunge the Terminal Disclaimer previously filed 12/12/2006.